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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,993	03/24/2004	Andrew Fikes	16113-764001/GP-089-04-U	9878
26192	7590	08/28/2007		
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER BOVEJA, NAMRATA	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 08/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/808,993	FIKES ET AL.	
	Examiner	Art Unit	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/6/04, 10/30/04, & 3/6/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 03/24/2004.
2. Claims 1-28 are presented for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 1 is rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter. 35 U.S.C 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). The applicants claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C 101. The claims begin by discussing a system (ex. claim 1: system for providing on-line advertising), but subsequently the claims then deal with the specifics of a method (the step of including a hyperlink reference to the advertisement) by the advertising creative interface (see rejection of claims under 35 U.S.C 112, second paragraph below, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 U.S.C 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 112

4. The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

5. Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is not sufficiently precise due to the combining of two separate statutory classes of invention in a single claim. The claims begin by discussing a system (ex. claim 1: system for providing on-line advertising), but subsequently the claims then deal with the specifics of a method (the step of including a hyperlink reference to the advertisement) by the advertising creative interface. The claim is interpreted as a system claim and the limitation "and including a hyperlink reference to the advertisement," is not given weight in this claim. Appropriate clarification is required.

6. Claims 13 and 26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the Applicant means by the limitation wherein the stored data comprises at least one of persistently-stored data. It is interpreted to mean stored data. Appropriate clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 6-10, 12-14, 19-23, and 25-28, are rejected under U.S.C. 103(a) as being unpatentable over Wagner et al. (Patent Number 7,062,466 hereinafter Wagner) in view of the Internet Archives print out of the Yahoo! Classifieds webpage from January 26, 2004 (hereinafter Yahoo).

In reference to claims 1, 14, 27, and 28, Wagner teaches a method, system, a computer-readable storage medium, and apparatus for providing on-line advertising, comprising: presenting an interface guiding on-line advertising creation (Figure 8), comprising: creating an advertisement from at least one of user inputs and stored data and comprising information describing at least one item (col. 5 lines 54 to col. 6 lines 12, and Figure 3); and generating an advertising creative in association with the advertisement (col. 5 lines 54 to col. 6 lines 12, and Figure 3); and hosting the advertisement on-line as a Web page and placing the advertising creative on one or more targeted Web pages (col. 5 lines 54 to col. 6 lines 12, and Figure 3).

Wagner does not specifically teach including a hyperlink reference to the advertisement. Yahoo teaches including a hyperlink reference to the advertisement (see under heading of Featured Listings). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Wagner to include a hyperlink reference to the advertisement to enable the presentation of detailed advertisement information for a product on the page directed to by the hyperlink.

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8. In reference to claims 6 and 19, Wagner teaches a method and system, further comprising: including at least part of the information in the advertising creative (col. 5 lines 54 to col. 6 lines 25, and Figure 3).

9. In reference to claims 7 and 20, Wagner teaches a method and system further comprising: an advertising creative generator to automatically generate the advertising creative from the information (col. 6 lines 57 to col. 7 lines 9, col. 8 lines 50-56, and Figures 4 and 9).

10. In reference to claims 8 and 21, Wagner teaches a method and a system further comprising: determining an advertising budget specifying compensation associated with the advertising creative (col. 6 lines 38 to col. 7 lines 9, col. 7 lines 66 to col. 8 lines 18, and Figures 3-5).

11. In reference to claims 9 and 22, Wagner teaches a method and system, wherein the advertising budget includes a budgeted compensation amount per unit of time (col. 6 lines 38 to col. 7 lines 9, col. 7 lines 66 to col. 8 lines 18, and Figures 3-5).

12. In reference to claims 10 and 23, Wagner teaches a method and system, further comprising: collecting compensation for on-line publication of the advertising creative in accordance with the advertising budget (i.e. it is inherent the advertiser's credit card is charged for the appropriate amount) (col. 5 lines 54-64 and Figure 3).

13. In reference to claims 12 and 25, Wagner teaches a method and system, wherein the item description comprises at least one of text, an image, price, contact information, and payment information (col. 5 lines 54 to col. 6 lines 56 and Figure 3).

14. In reference to claims 13 and 26, these dependent claims are further limiting the

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alternative limitation of stored data comprising at least one of persistently-stored data and a hyperlinked Web page, and since this alternative limitation stored data was not selected from the independent claims 1 and 14, the prior art still teaches the alternative limitation which was selected in claims 1 and 14 regarding creating an advertisement from at least one of user inputs, and therefore claims 13 and 26 do not need to be addressed as they pertain to the unselected alternative limitations of the independent claims.

15. Claims 2-5, 11, 15-18, and 24, are rejected under U.S.C. 103(a) as being unpatentable over Wagner in view of Yahoo and further in view of Radwin (Patent Number 7,007,074 hereinafter Radwin).

In reference to claims 2 and 15, Wagner teaches a method and system further comprising: an indexer to identify one or more advertisements relevant to a query, wherein the identified advertisements describe characteristics relevant to at least one item (col. 8 lines 37 to lines 56 and Figures 8 and 9); and a targeting component to provide the advertising creative associated with at least one such advertisement as Web-based content (col. 8 lines 37 to lines 56 and Figures 8 and 9).

Wagner doesn't specifically teach a scorer to score the advertisements based on match between the query and the characteristics of the identified advertisements.

Radwin teaches a scorer to score the advertisements based on match between the query and the characteristics of the identified advertisements (col. 7 lines 41 to col. 8 lines 24, col. 8 lines 40-59, col. 9 lines 4-39, col. 14 lines 20-29, and Figure 5). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's

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invention to modify Wagner to include a scorer to score the advertisements based on match between the query and the characteristics of the identified advertisements to enable the presentation of most relevant advertising to the user first followed by the least relevant information and to save the user time.

16. In reference to claims 3 and 16, Wagner does not specifically teaches a method and system, wherein a numerical score is assigned to the identified advertisements based on a degree of the match, and at least some of the identified advertisements are ranked by the numerical score. Radwin teaches a system, wherein a numerical score is assigned to the identified advertisements based on a degree of the match (col. 7 lines 41 to col. 8 lines 24, col. 8 lines 40-59, col. 9 lines 4-39, col. 14 lines 20-29, and Figure 5), and at least some of the identified advertisements are ranked by the numerical score (col. 7 lines 41 to col. 8 lines 24, col. 8 lines 40-59, col. 9 lines 4-39, col. 14 lines 20-29, and Figure 5). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Wagner to assign a numerical score to the identified advertisements based on a degree of the match, and to rank some identified advertisements by the numerical score to enable the presentation of most relevant advertising to the user first followed by the least relevant information and to save the user time.

17. In reference to claims 4 and 17, Wagner does not teach a method and system further comprising: providing at least some of the advertisements as the Web-based content in response to selection of the hyperlink reference of the associated advertising creative. Yahoo teaches providing at least some of the advertisements as the Web-

based content in response to selection of the hyperlink reference of the associated advertising creative, since it is inherent when a user clicks on the hyperlink for an advertisement, detailed information regarding the advertisement is presented to the user on the web (page 1 see the section titled featured listings). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Wagner to include a selectable hyperlink reference to the advertisement to enable the presentation of detailed advertisement information for a product on the page directed to by the hyperlink.

18. In reference to claims 5 and 18, Wagner teaches the method and system further comprising: targeting the advertising creative by associating one or more query terms with the item description (i.e. associating ad with car model type) (col. 8 lines 37-56 and Figures 8 and 9).

19. In reference to claims 11 and 24, Wagner teaches providing an advertising budget (col. 6 lines 38 to col. 7 lines 9, col. 7 lines 66 to col. 8 lines 18, and Figures 3-5). Wagner does not specifically teach the advertising budget based on at least one of per impression of the formatted advertisement, per click of the formatted advertisement and by a conversion of the at least one item. Radwin teaches providing an advertising budget for a cost per impression basis (i.e. per 1,000 matches or views) (col. 1 lines 19-38). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Wagner to include the advertising budget based on at least one of per impression of the formatted advertisement to enable the presentation of advertisement based on a per impression basis instead of just based on the amount of

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time or the type of device on which the advertisement will be displayed, and to therefore offer the advertiser an even more customized forum for advertising.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



NB

August 17th, 2007



RETTA YEHDEGA
PRIMARY EXAMINER